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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/772,071

Filing Date: February 04, 2004

Appellant(s): HUSTON ET AL.

Charles D. Huston
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/30/07 appealing from the Office action mailed 4/11/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(i) Appeal No. 2000-0947 (U.S. Patent Application 08/926,293, note correction from application number provided by Appellants), decision provided by Appellants (pp. 207-240 of paper entered 11/30/07)

(ii) C.A.F.C. 02-1048 (of Appeal No. 2000-0947), decision provided by Appellants (pp. 241-261 of paper entered 11/30/07)

(iii) Appeal No. 2005-2769 (U.S. Patent Application 09/454,813, A New Appeal is currently Pending) decision provided by Appellants (pp. 262-275 of paper entered 11/30/07).

Proceedings (i) and (ii) are directed to the parent application of the instant application and have a direct bearing on the instant application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-------------|--------------|---------|
| 5,524,081 | PAUL | 6-1996 |
| 5,364,093 | HUSTON et al | 11-1994 |
| 5,326,095 | DUDLEY | 7-1994 |
| WO 88/00487 | BONITO et al | 1-1988 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(9a) Claims 21-33, 35, 36, 38, 39, and 41 are rejected under 35 U.S.C.

103(a) as being unpatentable over Paul in view of Dudley (5,326,095).

Paul teaches a method and apparatus for displaying information to a golfer on a golf course using a global positioning satellite system comprising a GPS receiver 7 positioned on a golf course (Figure 1) for receiving signals from GPS satellites 2, a computer 16 for processing the received signals as well as differential correction information from receiver 9 for determining the position of the golfer, the computer is pre-loaded with retrievable, information relevant to

playing golf (4:28-29, 4:43-65, and 7:6-8) and thus obviously incorporates a storage element, and a graphical display device 18 for displaying information to the golfer. The processor (CPU) is pre-loaded with maps of the hole layouts 29 such that the golfer's position is displayed relative to the map and allows the CPU to calculate distances to targets and other critical information. Additionally, based on location, the unit retrieves stored messages in the form of pro's notes based on the current lie and other elements of the golfer's play (7:6-8); thus, suggesting a memory storing a set of message locations with associated messages. Paul also teaches the base unit broadcasting updated scores and information to the golfers thus suggesting the display of a scorecard (8:21-24). Additionally, Paul (2:41-51) specifically describes the disadvantages of a radio frequency system such as described by Dudley, using RF tags, and thus provides a motivation to substitute a GPS system for systems using buried RF tags to determine a golf cart location. Lastly, Paul teaches allowing the golfer to place food and beverage orders from the cart-mounted units ahead of time so that the order is available at the turn-around (8:40-50); this obviously suggests the display of a refreshment order page on the mobile unit.

Paul differs from the claimed subject matter since the retrieval and display of an 'advertisement' message associated with an advertising location is not specified, although Paul does suggest providing the golfer with additional types of information, including clubhouse notices, weather alerts, advertising, and leader board updates.

Dudley discloses "the look-up table contained in EEPROM 90 and RAMs 92 and 94 for microcontroller 88 can also include advertisement messages which are activated by particular tags 24" (7:14-17), thus teaching position-based retrieval of stored advertisement messages associated with advertising locations, i.e. the location of the tags, for display to a golfer.

Therefore, Dudley is deemed to clearly teach the desire to retrieve and display advertisements based on the position of a golfer. The desire to provide advertisements is by its very nature advantageous as a means to generate monetary gains for the golf course.

In summary, each of the claimed steps/elements is known in the art. Paul teaches an apparatus for use on a golf course including a GPS receiver for receiving GPS signals, a processor for determining position from the received GPS signals, a memory for storing position-based messages, the processor for comparing present position to locations stored in a memory for retrieving location-relevant pro's notes, and a display for displaying the retrieved messages. Dudley teaches an apparatus on a golf course which provides a plurality of advertising locations and a plurality of advertising messages associated therewith such that upon the golf cart detecting the position of the advertising location, the advertising message is retrieved and displayed. Paul discloses motivation to substitute GPS for RF tags for position determination on a golf course(2:41-51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paul by additionally providing location-based retrieval and display of advertisements in view of the conventionality of such as shown by Dudley since a skilled artisan would find the modification to be simply a substitution of one known element (position-based retrieval of advertisements) for another (position-based retrieval of pro's notes) to obtain a predictable result of the display of advertisements at selected locations on the golf course, while providing the predictable results of advertisements in the form of generating additional monetary gains for the golf course, particularly in light of the teachings of Paul as to the disadvantages of RF tag position determination. Additionally, it would have been obvious to

the skilled artisan to display advertising messages based on a condition of movement of the device, such as advertising restaurants when moving away from the 18th hole or providing advertisements for clothing and equipment while the golfer is stationary and waiting for a group ahead to finish, thus, providing the predictable result of advertising while not distracting the golfer from driving by providing information while stationary.

(9b) Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Dudley as applied to claims 32-33 above, and further in view of Bonito et al (WO 88/00487).

Paul in view of Dudley teach the apparatus for displaying a message to a golfer substantially as claimed as set forth above but fail to show the use of a pen for providing inputs to the display.

Bonito et al teach the conventionality of a light pen 95/97 to provide input with respect to a displayed graphic of a golf hole layout on a golf computer display 19.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paul by incorporating a pen as an input device over a graphical overlay in order to mark targets, such as sand traps and tree in the fairway, along the golf hole in view of the teachings of Bonito et al and thereby aid the golfer in selecting desired information with respect to selected targets on the golf layout using conventional means.

(9c) Claims 21-39 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,364,093 in view of either one of Paul (5,524,081) or Dudley (5,326,095).

Huston et al teach a method for displaying a distance to a golfer on a golf course using a global positioning satellite system comprising (1) positioning a remote GPS receiver on a golf course (claim 1, step 3), (2) determining a present position (claim 1, step 4) as well as a corrected position of the golfer (+claim 4), (3) storing cup locations on the golf course (+claim 8), (4) comparing the stored cup locations with the present position of the remote receiver, to determine distance (claim 1, step 5), and (5) displaying a distance between the golfer and a selected target, e.g., the cup location, on the golf course based on the present position and the stored cup location (+claims 10 and 11).

Huston et al do not disclose storing *one or more advertising locations* on the golf course and displaying *advertising messages* to the golfer if/when the present *position is an advertising location* as determined by the comparison of the present position to the stored positions.

Paul discloses “based on location, the unit retrieves stored pro’s notes 40 that provides strategy based on the current lie and other elements of the golfer’s play” (7:6-8). Moreover, Paul provides “selective information where and when it is needed . . . via a graphical display” (3:53-58). Lastly, Paul suggests providing further relevant information to the golfer via notices from the clubhouse, weather alerts, advertising, leader board updates, etc” (8:17-21). Dudley discloses “the look-up table contained in EEPROM 90 and RAMs 92 and 94 for microcontroller

88 can also include advertisement messages which are activated by particular tags 24" (7:14-17), the detection of the tags indicative of the golfer at a predetermined location.

It would have been obvious to one having ordinary skill in the art to modify Huston et al by combining position-based, advertising message retrieval and display in view of the conventionality of position-based retrieval and display of stored messages associated with locations on the golf course as taught by Paul in order to provide selective information to a golfer; Paul also teaches that information desired/relevant to the golfer includes weather alerts, advertising, and leader board updates. In view of *KSR*, it would have been obvious to one of ordinary skill in the art to substitute a known step of storing advertising messages associated with predetermined locations on the golf course, for the step of storing pro's notes for predetermined locations on the golf course, since the substitution provides results which would have been predictable; the golfer would be provided with relevant information while the presentation of advertisements by its very nature provides the predictable result of generating income for the golf course.

Alternatively, it would have been obvious to one having ordinary skill in the art to modify Huston et al by incorporating position-based advertising message retrieval and display, in view of Dudley who teaches that it is known to retrieve advertising messages associated with predetermined locations on a golf course from a storage element based on the location of a mobile receiver on the golf course. In view of *KSR*, one of ordinary skill in the art could have combined the storage of advertising locations in the storage device of Huston et al in view of the conventionality of such as shown by Dudley and provide a predictable result of retrieving

advertising messages at the stored advertising location resulting in the selling of products and generation of income for the golf course.

Additionally, Huston et al teach an apparatus for displaying advertising information to a golfer including the following elements: (1) a GPS receiver on a golf course (claim 15, “a global positioning receiver means”), (2) a processor for determining position of the receiver (claim 15, “means linked”), (3) a memory storing golf information associated with golf locations (claim 15, “memory means”), (4) “a” processor for comparing the present position with the stored golf locations (according to the appellants’ description of the claim, page 3 of the Brief, this corresponds to the same processor for determining position), and (5) a display (claim 15, “display means”).

Huston et al claim each of the elements of the instantly claimed apparatus but do not show ‘advertising’ information associated with ‘advertising’ locations stored in the memory and the comparison of the present position of the receiver with the stored ‘advertising’ information locations.

Paul discloses, on a golf course, the retrieval of information based on the present position of the golfer; it is clear that the retrieval of stored information which is pre-loaded into the computer of the golf information device suggests a memory for storing information associated with locations on the golf course. It would have been obvious to one having ordinary skill in the art to modify Huston et al by combining position-based, advertising message retrieval and display in view of the conventionality of position-based retrieval and display of stored messages associated with locations on the golf course as taught by Paul in order to provide selective information to a golfer; Paul also teaches that information desired/relevant to the golfer includes

weather alerts, advertising, and leader board updates. In view of *KSR*, it would have been obvious to one of ordinary skill in the art to substitute a known step of storing advertising messages associated with predetermined locations on the golf course, for the step of storing pro's notes for predetermined locations on the golf course, since the substitution provides results which would have been predictable; the golfer would be provided with relevant information while the presentation of advertisements by its very nature provides the predictable result of generating income for the golf course.

Dudley discloses, on a golf course, the conventionality of storing, retrieving and displaying advertisements to a golfer on the basis of position.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Huston et al by incorporating position-based advertising message retrieval and display, in view of Dudley who teaches that it is known to retrieve advertising messages associated with predetermined locations on a golf course from a storage element based on the location of a mobile receiver on the golf course. In view of *KSR*, one of ordinary skill in the art could have combined the storage of advertising locations in the storage device of Huston et al in view of the conventionality of such as shown by Dudley and provide a predictable result of retrieving advertising messages at the stored advertising location resulting in the selling of products and generation of income for the golf course.

(10) Response to Argument

Regarding the rejection of claims 21-33, 35, 36, 38, 39 and 41 on the grounds of 35 USC 103 over Paul in view of Dudley, the Appellants present arguments on pages 4-9 of the Appeal Brief. Firstly, Appellants discuss the scope and content of the prior art to Paul and

Dudley (Section A. i.) and concludes that one of ordinary skill in the art would not combine the teachings of Paul and Dudley because the combination would change the operating principles of both references. Secondly, the Appellants allege that even if Paul and Dudley are combined, the claim limitations are not taught or suggested (Section A. ii.). Lastly, the Appellants allege that one of ordinary skill in the art would not make the combination (Section A. iii.)

The Appellants' arguments with respect to the allegation that the operating principles are different and any modification would change the principles of operation of the prior art (in re Section A. i.) are not agreed with. The argument is not convincing since the modification to Paul is simply the use of the storage element, storing any of the pre-loaded data in a manner similar to storing the position-based pro's notes associated with predetermined location, for storing advertising messages associated with advertising locations. In the combination, there are no buried tags, rather, position is retrieved from the GPS receiver and simply compared to the memory for retrieving the advertising messages at the appropriate locations. Dudley suggests the retrieval and display of stored advertising messages on the basis of the golfer being associated with advertising locations; thus there is no change in the principles of operation since the principle of operation is simply the retrieval and display of an advertising message on the basis of the golfer being at an advertising location. Paul additionally supports the desirability of a golfer being provided with advertisements, even though in his embodiment, it is a broadcast.

The Appellants' arguments that the claimed limitations are not taught or suggested, even when the references are combined, is not agreed with (in re Section A. ii.).

Appellants allege "none of the cited references suggest the location determination techniques of the present invention." This is contrary to the teachings of Paul who clearly

disclose the use of a GPS receiver 6/7 on a golf course for receiving GPS signals and a computer 16 for determining location therefrom (5:35-52). Additionally, differential correction is taught. There is simply no distinction between the location determination techniques of the present invention in comparison with the prior art.

Appellants allege that the combination does not meet the claim limitations for “displaying the advertising message based on ‘the position of the remote receiver relative to the message locations’ wherein the position is determined with GPS.” The argument is contrary to the combination of references as set forth in the rejection since Paul teaches displaying messages (pro’s notes) based on the position of the remote receiver associated with a golfer in accordance with the message locations and Dudley supplies the teachings for substituting advertising messages at advertising locations on a golf course. Additionally, the Appellants’ quoted language does not agree with any claim limitations set forth in the claims. Appellants appear to be arguing a physical combination of the two references. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, the secondary reference supports a teaching of location-based advertising in a system that already supports location-based messaging using location determined from GPS.

Appellants allege that the combination of references fails to disclose (1) “memory storing a set of message locations on a golf course,” (2) “determining the position of a remote receiver

on a golf course using the global positioning system,” or (3) “using a GPS position to provide advertising information to a golfer. Regarding the memory, the argument is not convincing since the pre-loaded information associated with the computer of Paul stores information associated with at least the pro’s notes and the map data and therefore reads on a memory element; the retrieval of the pro’s notes based on location clearly teaches a set of message locations on the golf course. Regarding determining position on a golf course, Paul discloses a GPS receiver for determining position on the golf course as well as the use of differential corrections thereto. The combination of references suggests the retrieval of messages, pro’s notes and/or advertising, based on location, which location is determined by GPS in Paul. The position-based retrieval inherently compares the present position to the stored position in order to retrieve the position-based message. Appellants’ allegation that the Examiner has improperly pieced together aspects from each of these references is not persuasive, particularly since the only modification to Paul is the storage of advertising messages associated with advertising locations. Paul already discloses the storage of pro’s notes associated with particular locations on the golf course. Lastly, Appellants allege that the limitation of displaying the advertising message when the position of the receiver means coincides with one of the advertising locations is simply cumulative and addressed above by the combination of the position-based retrieval of messages for a golfer on a golf course as taught by Paul and the conventionality of advertisement message retrieval when a golfer position coincides with an advertising location. Appellants’ arguments with respect to a combination of features in different independent claims fails to distinguish the claims over the prior art.

Appellants apparently allege that a proper motivation to combine has not been explicitly provided (in re Section A. iii.). The Appellants remark has been considered but is not persuasive. The combination of references is set forth in the Office Actions as being obvious as a means to generate monetary gains through the use of advertisements. Moreover, Paul provides a clear motivation to substitute GPS position determining for RF tag positioning determining when he describes the disadvantages of setting up a system using RF tags, see 2:41-51).

Additionally, the combination of references is made obvious in view of the references themselves wherein GPS position-based retrieval of messages on a golf course is disclosed by Paul, who also suggests the desirability of a golfer to receive and display advertising messages. Dudley teaches the known element of position-based retrieval of advertisements on a golf course. The combination of the teachings of Paul and Dudley wherein the golfer would retrieve position-based stored advertisements is simply a substitution of one known element (position-based retrieval of advertisements) for another (position-based retrieval of pro's notes) to obtain a predictable result, the display of advertisements at selected locations on the golf course with the advantage of generating additional monies due to advertising.

Regarding the rejection of claim 34 on the grounds of 35 USC 103 over Paul in view of Dudley and Bonito et al, the Appellants state, at page 9 of the Appeal Brief, that it is patentably distinct for the same reasons as base claim 33. Claim 33 is dependent on claim 32. Claims 21-33, 35, 36, 38, 39 and 41 are grouped together by the Appellants. Thus, claim 34 stands or falls with the remaining claims with respect to the rejection over Paul in view of Dudley.

Regarding the rejection of claims 21-36, 38, 39 and 41 on the grounds of

Obviousness-type Double Patenting, the Appellants present arguments at pages 9-10 of the Supplemental Appeal Brief. Appellants argue that the claims of the patent are required to be used for a showing of obviousness-type double-patenting. However, as stated above in the rejection and previously in the Final Rejection, the rejection is read in light of the claims of the patent to Huston et al (5,364,093). Thus, the Appellants' remarks thereto are merely argumentative. Appellants argue that none of the claims of '093 fairly suggest the subject matter of the claims of the present application for "displaying an advertising message to a golfer on a golf course" at advertising locations. Though such a statement is true, the fact of the matter is that the rejection is based on obviousness in view of prior art. Thus, the Appellants' argument that the patent claims do not fairly suggest the instantly claimed subject matter is moot and does not address the rejection over a combination of references. Lastly, Appellants allege that there is no motivation to combine Paul or Dudley with the claims of the patent but fail to provide any evidence thereof. Thus, the Appellants' argument fails to particularly point out how the claimed subject matter distinguishes over the prior art combination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer. The Appellants list several Appeal that have a bearing as well as provides them in the attachment of 11/30/07.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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//Gregory C. Issing//

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